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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,937	09/15/2003	Kenneth Brazell	OWT 0195 PUS / PTG 1097 P	2020
757 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610	7590 11/16/2007		EXAMINER MAPLES, JOHN S	
			ART UNIT 1795	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/662,937

Applicant(s)

BRAZELL ET AL.

Examiner

John S. Maples

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-29 and 32-38 ~~is~~/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-29, 32-38 ~~is~~/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-16, 18-20, 23, 26-29, 32-35, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishay et al.-US 5,401,591 (Bishay) in view of Faust et al.-US 6,376,126. (Faust) (New Rejection with regard to claim 38)

Reference is made to the Abstract to Bishay along with column 2, line 27 through column 4, line 67 and in particular, column 2, line 63 through column 3, line 55 and column 4, lines 28-51. Also see Figures 1-4 in Bishay. These portions of Bishay teach an elastic bumper boot 106 that is "securably attached" (see column 4, lines 37-38) to the handle of a power tool. The flange portion of 122 is the projection of claim 5. As set forth in the above portions of column 4 in Bishay, the bumper has a durometer rating as

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applicant has claimed and is formed of an elastomer. The ribs of claim 8 are met by the four corners of the battery housing. The process limitations of claims 9-11 are met by the product in Bishay since the said steps add no patentable to product claims. In view of applicant using the term nominal, claims 12 and 13 are met by the teachings of Bishay because the said thickness of the elastic bumper is approximately the sizes claimed since the thickness of the bumper is known relative to a person's hand on the power tool handle. The battery housing 112 meets the claimed annular elastic member of claim 17. With regard to the vents in the top/floor of the battery cap, reference is made to Figure 3 of Bishay, the top drawing for the plural vents located in the cap portion (a top floor) of the battery housing.

The only claimed features not shown by Bishay are the adhesive bonding of the elastic bumper, the durometer rating of the annular elastic ring, the distance the latch projects from the housing and for the elastic member within the internal cavity. Faust discloses an elastic member 14 as seen in Figure 4 and in column 5, lines 8-35 and in column 6, line 62 through column 7, line 45 that is located within a battery cavity. To have incorporated the elastic member of Faust in the cavity of Bishay would have been obvious so that the batteries located therein would be provided with significant vibration dampening to preserve the same.

Bonding with an adhesive is a notoriously well known method to attach two members together and to join the elastic bumper to the battery pack in Bishay with an adhesive would have been obvious to provide a very secure fit between the two elements. This is especially obvious because Bishay sets forth the bumper being

"securely attached" to the pack as set forth in column 4 therein. The elastic ring having a durometer rating within that claimed would also have been obvious in view of the bumper itself having such a rating that provides for excellent properties. Finally, the claimed distance the latch moves is deemed obvious especially in view of the configuration of the button, latch and bumper thickness as described in the specification and drawings of Bishay and the same would provide for easy removal of the same.

Applicant's arguments have all been considered but are not deemed persuasive. Applicant argues that it is not proper to combine Bishay with Faust because the same would not allow replacement of the batteries in the housing of Bishay. The examiner respectfully disagrees. It is noted that the batteries in Bishay may be primary batteries and thus cannot be recharged-see column 1, lines 24-27 in Bishay and therefore the housings do not require separation.

3. Claims 21, 22, 24, 25, 36, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishay and Faust as set forth above and further in view of Pitzen et al.-US 5,553,675. (Pitzen)

The only claimed limitations not taught by Bishay are the tapered guide-way on the cap for receiving a mounting flange on the power tool and for the connectors in the guide-way. Pitzen discloses in the drawings and in column 11, line 31 through column 13, line 55, a tapered guideway for use with attaching a battery pack to a power tool. As set forth in Pitzen, the guideway has variance for receiving a mounting flange on the power tool. It is noted that the guide-ways in Pitzen also include dual connectors as seen in Figure 24 therein. To have included in the Bishay power tool/battery pack,

the tapered guideway with connectors as shown in Pitzen would have been obvious for the ease of securement of the battery pack onto the power tool and thus providing power to the power tool via the electrical connectors.

Applicant's arguments relating to this rejection have been considered but are not persuasive. Applicant argues that to include the teachings of Pitzen in Bishay would not be possible and would render Bishay inoperable and would not allow the battery pack to be inserted into the handle in the tool of Bishay. The mounting of the battery pack in Pitzen merely discloses a different way to attach a battery pack to a tool. To modify Bishay with the teachings of Pitzen would allow for an easier way to attach a battery pack to a tool.

Applicant further argues that Bishay engages the battery pack with the tool along a different axis than taught by Pitzen. This may be true, however, Pitzen teaches a different way to attach a battery pack to a tool and the same would provide a quicker way to attach a battery pack to a tool.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

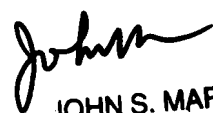
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Maples whose telephone number is 571-272-1287. The examiner can normally be reached on Monday-Friday from 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JSM/11-13-2007


JOHN S. MAPLES
PRIMARY EXAMINER